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FEET TRANSMITTAL for FY 2002 (Substitute form) <i>Patent fees are subject to annual revision.</i>		<i>Complete if Known</i>	
		Application Number	09/525,041
		Filing Date	Soppet, et al.
		First Named Inventor	March 14, 2000
		Examiner Name	Holleran, A.
		Group Art Unit	1642
Total amount of payment	\$0.00	Attorney Docket Number	PF178D2

1642
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METHOD OF PAYMENT						FEE CALCULATION (continued)							
1. <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:						3. ADDITIONAL FEES							
Deposit Account Number 08-3425						Fee Code	Large Entity Fee (\$)	Small Entity Fee (\$)	Fee Description			Fee Paid	
Deposit Account Name Human Genome Sciences, Inc.						105	130	205	65	Surcharge - late filing fee or oath			
<input checked="" type="checkbox"/> Charge Any Additional Fee Required Under 37 CFR §§ 1.16 and 1.17						127	50	227	25	Surcharge - late provisional filing fee or cover sheet			
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27						139	130	139	130	Non-English specification			
						142	1,280	242	640	Utility issue fee (or reissue)			
						195	300	195	300	Publication fee for early, voluntary, or normal publication			
						179	740	279	370	Request for Continued Examination (RCE)			
						098	130	098	130	Processing fee, except in provisional applications			
						126	180	126	180	Submission of Information Disclosure Statement			
						123	50	123	50	Processing fee for provisional applications			
						146	740	246	370	Filing a submission after final rejection (37 CFR 1.129(a))			
						149	740	249	370	For each additional invention to be examined (37 CFR 1.129(b))			
						145	100	145	100	Certificate of correction			
						147	2,520	147	2,520	Request for ex parte reexamination			
						099	8,800	099	8,800	Request for inter partes reexamination			
						148	110	248	55	Statutory disclaimer			
						115	110	215	55	Extension for reply within first month			
						116	400	216	200	Extension for reply within second month			
						117	920	217	460	Extension for reply within third month			
						118	1,440	218	720	Extension for reply within fourth month			
						128	1,960	228	980	Extension for reply within fifth month			
						119	320	219	160	Notice of appeal			
						120	320	220	160	Filing a brief in support of an appeal			
						121	280	221	140	Request for oral hearing			
						122	130	122	130	Petitions to the Commissioner			
						140	110	240	55	Petition to revive unavoidably abandoned application			
						141	1,280	241	640	Petition to revive unintentionally abandoned application			
						091	1,280	091	1,280	Acceptance of an unintentionally delayed claim for priority			
						561	3	561	3	Printed copy of patent, regular service			
						581	40	481	40	Recording each patent assignment per property (times number of properties)			
2. <input type="checkbox"/> Payment Enclosed: <input type="checkbox"/> Check <input type="checkbox"/> Credit Card <input type="checkbox"/> Money Order <input type="checkbox"/> Other*													
FEE CALCULATION													
1. BASIC FILING FEE													
Large Entity		Small Entity											
Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description									
101	740	201	370	Utility filing fee									
106	330	206	165	Design filing fee									
107	510	207	255	Plant filing fee									
108	740	208	370	Reissue filing fee									
114	160	214	80	Provisional filing fee									
				SUBTOTAL (1)				\$0.00					
2. EXTRA CLAIM FEES													
Total Claims		Extra Claims		Fee from below		Fee Paid							
		-20*		\$18.00									
Independent Claims		-3*		\$84.00									
				\$280.00									
Multiple Dependent													
Large Entity		Small Entity											
Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description									
103	18	203	9	Claims in excess of 20									
102	84	202	42	Independent claims in excess of 3									
104	280	204	140	Multiple dependent claim, if not paid									
108	84	209	42	" Reissue independent claims over original patent									
110	18	210	9	" Reissue claims in excess of 20 and over original patent									
				SUBTOTAL (2)				\$0.00					
* or number previously paid, if greater: For Reissues, see above													
* Reduced by Basic Filing Fee Paid													
SUBTOTAL (3) \$0.00													

Submitted By		Complete (if applicable)	
Name (Print/Type)	Jonathan L. Klein	Registration No.:	41,119
Signature:	Date: 12/3/01		

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Soppet, et al.**

Application No.: **09/525,041**

Art Unit: **1642**

#

Filed: **March 14, 2000**

Examiner: **Holleran, A.**

11

For: **Colon Specific Gene and Protein** Atty Docket No.: **PF178D2**

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1-7-01

PROVISIONAL ELECTION WITH TRAVERSE
UNDER 37 C.F.R. § 1.143

Commissioner of Patents
Washington, D.C. 20231

Dear Sir or Madam:

In response to the Office Action mailed November 6, 2001 please consider the following provisional election with traverse. Applicants submit concurrently herewith a Fee Transmittal Sheet.

Provisional Election and Traverse

The Examiner has required restriction of the claimed subject matter into one of two different groups.

In order to be fully responsive, Applicants hereby provisionally elect, with traverse, the subject matter of Group I (claims 21-37, 46-63, 72-89, 98-115, and 124). Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final. Additionally, should the present restriction requirement be made final, Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Applicants respectfully traverse and request the withdrawal of the Restriction Requirement.

As a threshold matter, Applicants note that the Examiner has required restriction based on an assertion that the "product as claimed can be used in a materially different process of using that product." *See*, Paper No. 10, page 2, last paragraph. In particular, the Examiner asserted "the antibodies of Group I may be used in *in vivo* methods of treatment." And further, "[a]n *in vivo* method of treatment is a materially different method than the *in vitro* method of detection of an antigen." *See*, Paper No. 10, page 2, last sentence to page 3, first full sentence.

Applicants respectfully traverse.

As a threshold matter, the possibility of an alternative use alone is not sufficient to impose a restriction requirement. Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a "serious burden." *See* M.P.E.P. § 803. In the present situation, no such showing has been made.

Although the Examiner has indicated that Groups I and II are separately classified, Applicants submit that a search of the composition claims of Group I would largely overlap (and therefore provide useful information for) a search for the method claims of Group II. For example, a search for publications drawn to antibodies of the present invention would largely overlap with a search directed toward methods of detecting the protein to which said antibodies bind.

Thus, the search and examination of the composition and method claims would not entail a serious burden. Accordingly, in view of the above traverse, Applicants respectfully request that the Restriction Requirement be withdrawn so the subject matter of all the groups can be examined together.

Should the restriction requirement not be withdrawn, in order to expedite prosecution of this case, Applicants provisionally elect, *with traverse*, the subject matter of Group I represented by claims 21-37, 46-63, 72-89, 98-115, and 124.

Furthermore, if the restriction requirement is maintained, Applicants request rejoinder of the claims of Group I and II once the claims of Group I are found allowable. In light of the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ 2d 1663 (Fed. Cir. 1996), a notice was published in the Official Gazette which set forth new guidelines for the treatment of product and process claims. See 1184 OG 86 (March 26, 1996). Specifically, the notice states that:

in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim.

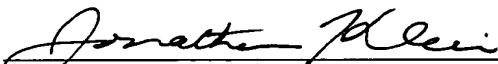
Id. Accordingly, if claims of Group I are found allowable, Applicants respectfully request that the claims of Group II be rejoined and examined for patentability. See also M.P.E.P. § 821.04.

CONCLUSION

Applicants respectfully request that the remarks above be entered and made of record in the file history of the instant application.

Respectfully submitted,

Date: DECEMBER 3, 2001


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